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Serial No. 09/415,696

Response to Final Rejection (4 pages)

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PTO/SB/21 (08-03)

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**TRANSMITTAL  
FORM**

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Total Number of Pages in This Submission

6

Application Number

09/415,696

Filing Date

October 12, 1999

First Named Inventor

Donald K. Wright

Art Unit

3727

Examiner Name

Jes F. Pascua

Attorney Docket Number

21276.00.9044

**ENCLOSURES (Check all that apply)**

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Date	10/31/03

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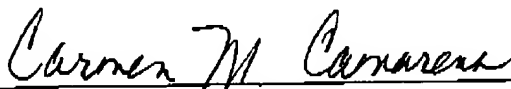
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Serial No. 09/415,696; First Named Inventor: Donald K. Wright; Filing Date: October 12, 1999; Art Group: 3727; Attorney Docket No.: 21276.00.9044; Title: RECLOSABLE FASTENER PROFILE SEAL AND METHOD OF FORMING A FASTENER PROFILE ASSEMBLY

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- \*Transmittal Form; and
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PATENT

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Applicant: WRIGHT et al.  
Appeal No. 2003-0068  
Application No. 09/415,696  
Filing Date: October 12, 1999Examiner: J. Pascua  
Art Group: 3727

Atty. Docket No. 21276.00.9044

Title: RECLOSABLE FASTENER PROFILE SEAL AND METHOD OF  
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DateCarmen M. Camarena  
Carmen M. CamarenaRESPONSE TO FINAL REJECTION

Dear Sir:

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The Applicants of the above-identified patent application, timely-filed a Request for Continued Examination (RCE) on September 10, 2003. When the RCE was filed, new claims also 22-26 were submitted for examination, which directed to a method of manufacturing a reclosable plastic bag, using method steps that were fully enabled in the originally filed-application.

In response to the RCE, a first Office Action was mailed October 24, 2003.

In the October 24<sup>th</sup> Office Action, new claims 22-26 were "withdrawn from consideration" by the Examiner under the provisions of 37 C.F.R. 1.142(b). The Applicants consider the Examiner's withdrawal of these claims as a Restriction Requirement and reserve the right to prosecute these claims by way of a divisional application.

In addition to withdrawing claims 22-26, the Examiner finally rejected the pending claims because, as he said, "for the reasons set forth in the Board Decision of 7/11/03." (Emphasis added.)

It was improper for the Examiner to issue a final rejection on a first Office Action for at least two reasons set forth below. The Applicants request that the final rejection be withdrawn and that the claims be examined as required by 37 C.F.R. 1.104. If the Examiner cannot find

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Amdt. dated October 31, 2003

Reply to Office Action of July 2, 2002, and the Decision on Appeal of July 11, 2003

each and every one of the limitations of the pending claims in the prior art, the claims should be allowed to issue.

*Tilman Refutes the Examiner's Determination of an Inherent Air Tight Seal*

First, it was improper for the Examiner to maintain his rejection of the pending claims in light of the Declaration of Paul A. Tilman. As the Examiner stated to the Board of Appeals, his rejection of the pending claims is based on his opinion that the '689 Tilman reference inherently disclosed an airtight seal.<sup>1</sup> In their Appeal, the Applicants disputed the Examiner's opinion that the '689 Tilman patent disclosed an airtight seal and argued that the '689 Tilman does not teach an air tight seal and that spot sealing cannot produce an airtight seal.

In affirming the Examiner's rejection in the Board's Decision of July 13, 2003, the Applicants were challenged by the Board to come up with evidence supporting their argument that the '689 Tilman patent did not teach an airtight seal. During an October 29<sup>th</sup> telephone conference with the undersigned, the Examiner acknowledged that the Board of Appeals so challenged the Applicants.

Whether a prior art reference inherently teaches a limitation or an entire claim is a question of fact.<sup>2</sup> Therefore, whether the '689 Tilman reference inherently teaches an "airtight" seal is also a question of fact.

There can be no more compelling evidence of what the '689 patent inherently teaches than the testimony of the patent's named inventor. In response to the Board's challenge to come up with evidence that the reference does not teach an airtight seal, when the Applicants filed the RCE, they submitted sworn declaration testimony of the sole inventor of the '689 patent. In his Declaration, Mr. Paul A. Tilman states that the '689 Tilman patent does not inherently or expressly teach an airtight seal under any definition of airtight. The Declaration of Paul A. Tilman clearly and unequivocally resolves the shows that the '689 Tilman patent does not teach

<sup>1</sup> The words "air tight" and "airtight" do not appear anywhere in the '689 Tilman patent.

<sup>2</sup> Schering Corp. v. Geneva Pharmaceuticals Inc. et al., 339 F.3d 1373, 1377 (Fed. Cir. 2003) ([I]nherency, like anticipation itself, requires a determination of the meaning of the prior art.)

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an airtight seal. It clearly refutes the Examiner's opinion that the '689 Tilman seal is inherently airtight.

In paragraph 13 of his Declaration, Mr. Paul A. Tilman stated that "the... '689 patent does not explicitly or inherently provide a seal that is airtight under any definition of airtight." (Emphasis added.) The Examiner's final rejection of the pending claims by his maintenance of his rejection based on an allegedly "inherent" disclosure of an airtight seal was improper and should be withdrawn in light of the Board's Decision and the evidence submitted by the Applicants.

Contrary to statements of the Examiner in the Office Action Mr. Tilman does not narrow or revise the '689 patent. Mr. Tilman's Declaration identifies an artifact of spot sealing that was clearly disclosed in Fig. 4 of the patent but apparently still unappreciated by the Examiner, namely that the spot sealing disclosed in the patent is incapable of producing an airtight seal.

It was improper to finally reject the claims on new grounds for rejection

Secondly, the final rejection should also be withdrawn because the Examiner rejected the claims on an entirely new basis. In the Office Action, the Examiner attempted to avoid the effect of the Tilman Declaration by ostensibly finding that the '689 Tilman seal might be airtight under some (unidentified) atmospheric pressures, and (presumably) in such a case, the pending claims would then read on a prior art reference, rendering them invalid. The Examiner's newly articulated reading of the '689 Tilman patent is, in effect, new grounds for rejection. Under 37 C.F.R. 1.113, it was wholly improper for the Examiner to issue a first office action final rejection on an entirely new and previously unarticulated basis (i.e., that the '689 Tilman patent might teach a seal that is airtight under some vague and/or unarticulated atmospheric pressures.)

Even if the Examiner's new basis of rejection had been known, paragraph 13 of the Declaration of Paul A. Tilman contradicts the Examiner. Mr. Tilman clearly states in paragraph 13 of his Declaration that the '689 patent does not provide an airtight seal under any definition of airtight. He also states in paragraph 13 that: "[t]he structure and method disclosed in the '689 patent will inherently leak air and other gaseous molecules through an air gap located between the extent of the sealing structures 14 and 15 and the spot seal produced by spot sealing means." (Emphasis added.) In light of the statements made in his Declaration, there can be no doubt that the '689 Tilman patent does not teach an airtight seal – regardless of the atmospheric conditions.

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The Applicants submit that if the Examiner maintains the rejection of the claims on the basis of the '689 Tilman patent, he will necessarily do so on the basis of personal knowledge, i.e., that he knows more about the '689 Tilman patent than Mr. Tilman himself. In such an event, the Applicants request the Examiner to substantiate his rejection as required by 37 C.F.R. 1.04(d)(2). If the Examiner testifies from personal knowledge or otherwise contends that the '689 Tilman patent might somehow be airtight under some undisclosed atmospheric conditions, the Applicants reserve the right to supply a responsive declaration from Mr. Tilman.

The claims avoid the prior art and in condition for allowance

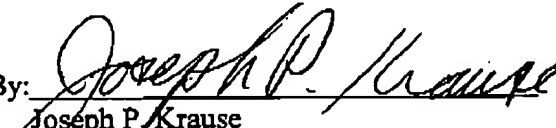
The Applicants met the challenge put to them by the Board on July 13<sup>th</sup>. It was therefore improper for the Examiner to maintain the rejection of claims 1, 4-10, 18 and 19 for the same reasons set forth by the Board in its July 13<sup>th</sup> decision. Secondly, it was improper for the Examiner to finally reject the claims on a new ground for rejection.

By filing the RCE – and paying the requisite fee for an examination, the Applicants are entitled to an examination of the pending claims. If the Examiner cannot find the claimed subject matter in the prior art, under the plain language of 35 U.S.C. §102, the Applicants "shall be entitled to a patent."

In light of the foregoing, the Applicants request that the final rejection be withdrawn. The Applicants also request examination of the pending claims and their allowance if the Examiner is not able to find the pending claim limitations in the prior art.

Respectfully submitted,

By:

  
Joseph P. Krause  
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Date:

10/31/2003

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